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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,494	08/29/2006	Kazuo Tagawa	07481.0045	5119
22852	7590	01/04/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VASISTH, VISHAL V	
			ART UNIT	PAPER NUMBER
			1797	
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			01/04/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,494

Applicant(s)

TAGAWA ET AL.

Examiner

VISHAL VASISTH

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/225)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Applicants' response filed on 9/17/2009 amended independent claims 10, 13 and 16. Applicants' amendment overcame the claim objection to claim 10 from the office action mailed on 12/15/2008, therefore the claim objection is withdrawn. Applicants did not file a terminal disclaimer to obviate the double patenting rejection from the office action mailed on 12/15/2008. Therefore this rejection is maintained below. Applicants' amendments necessitated a new ground of rejection set forth below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiki et al., US Patent No. 5,403,503 (hereinafter referred to as Seiki).

Seiki discloses a refrigerator oil composition comprising a polyester base oil exemplified by reaction products represented by a polyhydric alcohol such as ethylene glycol and a monobasic aliphatic acid having 1 to 20 carbon atoms such as dodecanoic acid (base oil of claims 10 and 12-13 and 16) (Col. 3-4/L. 41-44).

The composition of Seiki further comprises additives including a polyhydric alcohol partially esterified with an aliphatic acid. The term "polyhydric alcohol" includes

alcohols such as glycol and trimethylol propane esterified with acids having 1 to 24 carbon atoms (component (A6) of claim 13 and component (A8) of claim 16) (Col. 5/L. 45-59). Additional additives disclosed in Seiki include either a phosphate or phosphite compound or both (phosphorus additive as recited in claims 14 and 17) (Col. 5-6/L. 67-49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

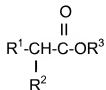
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiki in view of Kawahara et al., US Patent No. 6,667,285 (hereinafter referred to as Kawahara). The examiner notes that this is the US national phase application (therefore in English) of WIPO application No. WO/2000/068345 which is in Japanese and has a 102(b) date.

Seiki discloses a refrigerator oil composition comprising a polyester base oil exemplified by reaction products represented by a polyhydric alcohol such as ethylene glycol and a monobasic aliphatic acid having 1 to 20 carbon atoms such as dodecanoic acid (base oil of claims 10 and 12) (Col. 3-4/L. 41-44).

The composition of Seiki further comprises additives including either a phosphate or phosphite compound or both (phosphorus additive as recited in claims 10) (Col. 5-6/L. 67-49) and a polyhydric alcohol partially esterified with an aliphatic acid. The term "polyhydric alcohol" includes alcohols such as glycol and trimethylol propane esterified with acids having 1 to 24 carbon atoms present in the composition in a concentration ranging from 0.1 to 10 wt% based on the total amount of the composition (encompasses and is within the range as recited in claim 11) (Col. 5/L. 45-59). Seiki does not, however, explicitly disclose an ester additive that is the esterification product of a monobasic fatty acid and monohydric alcohol.

Kawahara discloses a lubricating oil composition for refrigerators comprising hydrocarbon oils (predetermined base oil) (Col. 3/L. 39) and at least one aliphatic saturated branched-chain carboxylic acid monoalkyl ester represented by the formula:



wherein when R^2 is hydrogen, R^1 is a branched-chain alkyl and R^3 is $\text{C}_1\text{-C}_{20}$ straight-chain alkyl (monoesters of a monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms (as recited in claim 10) (Col. 2-3/L. 64-

15). The composition of Kawahara may further contain other base oils such as alicyclic dicarboxylic acid esters esterified by monohydric alcohols (Col. 14/L. 21-26 and Col. 15-16/L. 55-3) (as recited in claim 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the ester additive of Kawahara in the refrigerant composition of Seiki in order to enhance the hydrolytic stability, electrical insulating properties and miscibility with refrigerants of the composition (Col. 2/L. 53-63 of Kawahara).

Claim Rejections - 35 USC § 103

7. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiki in view of Shimomura et al., US Patent No. 6,228,282 (hereinafter referred to as Shimomura).

Seiki discloses all of the limitations as applied to claims 13 and 16 as discussed above including phosphorus containing additives including phosphates and/or phosphites. In addition Seiki further discloses thiophosphate additives (Col. 7/L. 15-20). Seiki does not, however, explicitly disclose the use of a phosphorothionate and a phosphorus additive apart from the phosphorothionate.

Shimomura discloses a refrigerator oil composition comprising an alicyclic polycarboxylic acid ester compound, an epoxy compound and additives which improve wear resistance and load capacity such as phosphoric esters (phosphorus compound) and sulfur compounds to further improve wear resistance and load capacity such as phosphorothionates (Col. 7-8/L. 16-31). It would have been obvious to one of ordinary

skill in the art at the time of the invention to modify the composition of Seiki with the phosphorothionates of Shimomura in order to enhance the wear resistance and load capacity of the composition (Col. 8/L. 18-20 of Shimomura).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 10-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/565,739. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The copending application claims a refrigerating machine oil composition comprising a base oil, a phosphorus-based extreme pressure agent and an oil agent

(ester additive wherein the ester additive is monoesters of a monobasic fatty acid having 12 or more carbon atoms as recited in claim 10). The base oil contains at least one of an ester of polyhydric alcohols and monobasic fatty acids or an ester of alicyclic dibasic acids and monohydric alcohols (as recited in claim 12). Also, the phosphorus-based extreme pressure agent is a phosphorothionate and another phosphorus compound is used in the composition that is separate from the phosphorothionate (as recited in claims 14-15 and 17-18). The oil agent is an ester oil agent and can be one of esters of monobasic acids and monohydric alcohols or esters of linear dibasic acids and monohydric alcohols (as recited in claim 10). The monobasic acids have to have more than 12 carbon atoms and the ester additive is present in the range between 0.01-10 wt% based on the total weight of the composition (as recited in claim 11). Furthermore, the copending application further comprises an epoxy compound (alkylene oxide adduct of polyhydric alcohol having 3-6 hydroxyl groups wherein the alkylene oxide compounds can be epoxide compounds as recited in claims 13-16). The instant application recites a refrigerating machine oil composition comprising a predetermined base oil, at least one ester additive wherein the ester additive is monoesters of a monobasic fatty acid having 12 or more carbon atoms present in a range from 0.01 to 10 mass%. The base oil is an ester of an alicyclic dibasic acid and a monohydric alcohol. The composition further comprises an alkylene oxide adduct of polyhydric alcohol having 3-6 hydroxyl groups wherein the alkylene oxide compounds can be epoxide compounds (Para. [0170] of the instant application), a phosphorus additive and a phosphorothionate

additive which is separate from the phosphorus additive. Therefore, the co-pending application renders the instant application obvious in terms of scope of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicants' arguments filed on 9/17/2009 with respect to claims 10-18 have been fully considered and are moot in light of the new grounds of rejection set forth above.

Conclusion

11. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797